

Remarks/Arguments

35 U.S.C. § 112

The Office rejected claims 3,4,6,7, 11-17 as being indefinite for failing to particularly point out and distinctly claim “a motorized base”.

Applicant submits that the “motorized base” is that which provides power to the drive.

The claim rejections are respectfully traversed by this clarification.

35 U.S.C. § 102

Grams

The examiner considers claims 5-7 and 11-17 to be anticipated by Grams et al. (Grams) (U.S. Patent No. 6,371,717). The applicant respectfully disagrees for the reasons stated below.

“Anticipation under 35 USC § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention...” *Rockwell International Corp. v. United States*, 147 F.3d 1358, 1363, 47 USPQ2d 1027, 1031 (Fed. Cir. 1998), (emphasis added).

Amended claim 5 recites a plurality of extendable arms. This limitation is not found in Grams; it appears that the examiner is in agreement with the previous sentence having directed the applicant to Tolsma to find extendable arms. Based on the failure of Grams to disclose extendable arms, claims 5-10 are not anticipated by Grams.

With regard to amended claim 11, Grams fails to disclose a sensor for sensing the amount of distress on the device created by the weight of the bottle. The examiner directs applicant to column 7, lines 47-53 for disclosure of this element, however, the sensor that Grams teaches is one which indicates open and closed states. Claim 11 clearly recites that the sensor senses an amount of stress, not an open and closed state. Accordingly, Grams does not anticipate independent claim 11 or dependent claims 13 and 14.

Tolsma

The Office also considers claims 1, 5-7, 8, 11, and 13-18 to be anticipated by Tolsma.

Addressing amended claim 1 first, it appears that the examiner considers Tolsma to disclose extendable arms. While the arms in Tolsma may move between gripped and non-gripped positions, this does not equate to extendable. Extendable as it related to the subject matter before the Office, means that the length of the arms - as measured from the frame to the gripping heads - can vary. In Tolsma, the length of the arms, as measured from the frame, does not vary.

Amended claim 5 also recites extendable arms and is therefore not anticipated by Tolsma for the same reasons at amended claim 1.

Amended claim 11 recites a sensor for sensing the amount of stress on the device created by the weight of the bottle. This limitation is not disclosed in Tolsma; it appears that the examiner is in agreement with the previous sentence having directed the applicant to Grams to find a such a sensor. Based on the failure of Tolsma to disclose any sensor at all, claims 11-14 are not anticipated by Tolsma.

Claim 18 also recites extendable arms and for that reason Tolsma does not anticipate claim 18.

35 U.S.C. § 103

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Even if the references were combined, there is no teaching or suggestion of an extendable arm or of a sensor that senses stress caused by weight of the bottle.

Although the examiner considers Grams to teach a sensor, the examiner has failed to meet his burden to present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time

to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the differences. The tendency to resort to hindsight based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. Absent hindsight, the mere mention of the word "sensor" in the prior art does not make obvious a claim element that requires a particular kind of sensor.

Conclusion

Of the claims that were examined, all independent claims recite either an extendable arm or a sensor for sensing stress caused by the weight of a bottle. However, neither reference discloses, teaches, or suggests these limitations. Based on the failure to anticipate or make obvious the present claims, the applicant submits that the claims are in condition for allowance.

Respectfully submitted,

Rutan & Tucker, LLP

Dated: December 29, 2003

By:



Robert D. Fish
Reg. No. 33,880

Attorneys for Applicant(s)
Post Office Box 1950
Costa Mesa, CA 92628-1950
Tel: (714) 641-5100
Fax: (714) 546-9035